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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,764	05/04/2001	Sakae Ishikawa	207187US2	7828

22850 7590 11/17/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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BUTLER, MICHAEL E

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/848,764

Applicant(s)

ISHAKAWA 

Examiner

Michael Butler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 8/23/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-10 and 12-71 is/are pending in the application.
- 4a) Of the above claim(s) 12-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15/17.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Priority***

1. Applicant's claims of priority to Japanese applications: 2001-47288 filed 2/22/01; 2000-356640 filed 11/22/00; 2000-135235 filed 5/18/00.

### ***Election/Restriction***

2. Applicant's election of invention I without traverse in Paper No. 12 was acknowledged and made final. Applicant's election of Species I with traverse in Paper No. 12 is acknowledged and the species requirement is made final. Applicant identified claims 1-11 as reading on the elected species.

MPEP § 816 relates to patentably distinct inventions, not species.

Applicant asserts no mutually exclusive species have been identified:

Applicant per MPEP § 806.04(f), there was no identification of mutually exclusive species. Same time and different time are clearly mutually exclusive times. Same location and different locations are clearly mutually exclusive. Same type product and differing type product are mutually exclusive products.

Applicant argues there would be no undue burden to all claimed species.

However, burden is a restriction requirement element, not a species requirement element.

### ***IDS***

3. The information disclosure statement filed 5/21/01 to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

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4. The information disclosure statement # 15/17 filed 12/17/03 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language, and because it fails to comply with 37 CFR 1.98(a)(2) because it does not include a copy of each cited reference. The US references have been printed and considered, but the Japanese cited references have not been considered. They were placed in the application file, but the information referred to therein has not been considered.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States
- (c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-2 and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Knudsen, Jr. which discloses:

(Re: cl 1) A specification unit 25 configured to specify a plurality of first rack components required to assemble rack and those not required for first rack yet required for second rack (c9 L 29-c10 L 13; c4 L 14-30);  
Instruction unit configured to provide delivery procedure for second article (c12 L 6-45);

(Re: cl 2) pallet with top and plurality of supports or shock absorbers (c5 L 1-29)

(Re: cl 7) third rack (c8 L 18-34)

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(Re: cl 5) instruction unit includes confirmation unit; rack collection center (c10 L 58-67)

(Re: cl 6) if confirmed no stocking of second rack component at rack collection center instruction unit instructs management center to deliver rack (c7 L 41-c8 L 43)

(Re: cl 8) instruction unit includes first and second instruction units (c7 L 41-c8 L 17; 25/33).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knudsen, Jr. in view of Otsuka et al. wherein Knudsen, Jr. discloses the elements previously discussed and Otsuka et al. discloses:

(Re: cl 3) system sales use warehouse; rack assembled with components production site (c5 L 1-35)

(Re: cl4) instruction unit instructs management center to deliver rack (c5 L 1-35).

It would have been obvious at the time of the invention to move production task completed articles to storage warehouse to have them out of the way till ready for further work or shipment as taught by Otsuka et al..

9. Claims 1-2 and 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knudsen, Jr. wherein Knudsen, Jr. discloses the elements previously discussed.

The examiner takes official notice that it is well known to transport computer systems together including image forming apparatus such as computer systems with printers with monitors and memory storage devices. It would have been obvious at the time of the invention to transport permutations of printers, monitors, and computer

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together on a rack as these components are regularly used and sold together and there common transfer would help users get the components together and come up with the instant inventions.

***Response to Amendments/Arguments***

10. Applicant's amendment has overcome the indefiniteness and so the rejections under 35 USC 112 second paragraph are withdrawn. The applicant's arguments have been fully considered but they are unpersuasive in overcoming the prior art rejections.

Knudson, Jr. has items specified for the order for assembly in the rack. There is not a claim limitation for common components in both a first rack and a second rack.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exmr. Michael E. Butler whose telephone number is (703) 308-8344.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh, can be reached on (703) 306-4173. The fax number for the Group is (703) 305-7687.



Michael E. Butler

Examiner



DONALD R. WALSH  
SUPERVISORY PATENT EXAMINER  
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